

Office Action Summary

Application No.
09/283,645

Applicant(s)
Khetani et al.

Examiner
Celia Chang

Art Unit
1625



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 29, 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-13, and 15 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-13, and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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DETAILED ACTION

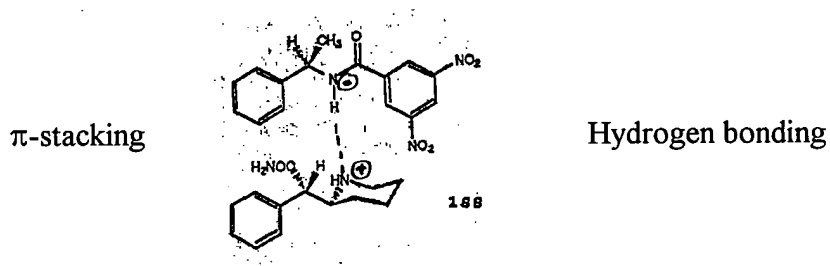
1. Response filed by applicants in Paper No. 12, dated May 29, 2001 has been entered and considered carefully.

2. The rejection of claims 1 and 15 under 35 USC 102(b) over Jursic et al. is maintained for reasons of record.

The gist of applicants' argument is that

(1) Jursic should not be considered as an "acid resolving agent" because an acid requires "removable" hydrogen. Please note that it is well known that acid is "proton donor" or an "electron pair acceptor" (see Morrison and Boyd textbook supplied p.33), therefore, does not limit to "removable" hydrogen.

(2) Jursic did not disclosed the formation of a salt. In the instant case, a complex involving hydrogen bonding is formed between the amide moiety and the amine of the piperidine ring (claimed compound) to form a salt complex i.e.



Such complexes are disclosed in table 1, page 1714, being formed between the resolving agents and enantiomers through amide hydrogen bonding for which delineation supra is made.

(3) Jursic does not disclosed isolation of salt. Please note that the complex formed between an acid and a base is a salt (see Morrison and Boyd textbook supplied p.34). The salts not only have been described but also isolated as seen in the chromatogram of p.1714. As described on p.1714 each peak of salt complex is identified, separated, and the chiral separating

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agent is recovered. Therefore, the rejection is proper when the scope of the claims are read with conventional well known definition for the terms and anticipation is found.

3. The rejection of claims 1-8, 10-11, 13 and 15 under 35 USC 103(a) over Jursic et al. In view of Berrang, Ohashi or Vanderplas is maintained for reason of record.

The gist of applicants' argument is that the Jursic reference disclosed amide resolving agents which would not motivate one skilled in the art to employ an acid resolving agent and from the name of tartranilic acid it was clear that tartranilic acid has an acid functionality, therefore, would not provide evidence of equivalency between acid resolving agent containing an COOH group with an acid resolving agent containing an CONH₂ group.

As it was explained again supra that Jursic disclosed that the resolving agent disclosed are "acidic" in function and the definition of acid and base has far advanced from mere having a COOH group. In addition, the structure of tartranilic acid is hereby attached for applicants' convenience. Please note that tartranilic acid is the CONH₂ i.e. the amide of tartaric acid and the two have been known to function interchangeably.

4. The rejection of claim 12 under 35 USC 103(a) over Jursic in view of Berrang, Oshashi or Vanderplas further in view of Patrick is maintained for reason of record. Applicants made no comments on this rejection.

5. The rejection of claims 1-8, 10-13 and 15 under the judicially created doctrine of obviousness type double patenting over US 5,936,091 is maintained for reason of record because no terminal disclaimer was filed.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is (703) 308-4702. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

CCC/Chang

Aug. 7, 2001



CEILA CHANG
PRIMARY EXAMINER
GROUP 1200 1625